

REMARKS

Claims 1-137 remain in connection with the present application. Claims 1, 22, 36, 45, 52, 61, 71, 94 and 110 are the independent claims in the application.

Information Disclosure Statement

Initially, Applicants wish to thank the Examiner for consideration of the documents submitted with the Information Disclosure Statements of August 27, 2003 and October 10, 2003. **However, Applicants have not received any indication of the Examiner's consideration of the documents filed with the Information Disclosure Statement of January 11, 2002.** Accordingly, Applicants respectfully request consideration of these documents, and **Applicants respectfully request the Examiner to initial and return an enclosed additional copy of the PTO-1449 Form submitted with the Information Disclosure Statement of January 11, 2002,** acknowledging the Examiner's consideration of each of the document submitted in the aforementioned Information Disclosure Statement.

Claim Rejections Under 35 U.S.C. §112

The Examiner has rejected claims 36, 52 and 61 under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

The Examiner alleges that in claim 36 and in claims 52 and 61, the term "adapted to" is unclear. The Examiner alleges that it does not constitute a limitation of the claims in any patentable sense, citing *In re Hutchison* 69 USPQ 138 (CCPA 1946). Applicants disagree.

Upon review of *Hutchinson*, supra, it is first apparent that the case was decided by the CCPA in 1946 and thus was decided prior to the Patent Act of 1952. In addition, when

reviewing the *Hutchinson* decision, it is clear that the independent claims 42 and 58 in the case do include the phrase “adapted to”, **but the phrase is used in the preamble of the claim to designate a field of use of the article.** For example, claim 42 states “as an article of manufacture, adapted for use in the fabrication of a metal template ...”. In referencing claim 42, the Court states that such a limitation is in the “introductory clause” of the claim and as such, does not constitute a limitation in a patentable sense. See *In re Hutchison*, 69 USPQ at 141. It further does not even hold that the phrase “adapted” for use in the making of a template or the like is not a limitation, but states that if it were such a limitation, it is anticipated by another reference which taught a laminated sheet which may be used in the making of a template. As such, the Court actually held that the claim was anticipated by the Moxon Patent.

Applicants refer the Examiner to MPEP §§ 2173.02 and 2173.05(e). MPEP §2173.02 indicates that the Examiner’s focus during examination of the claims for compliance with the requirements of definiteness under 35 U.S.C. §112, second paragraph, **is whether the claim meets the threshold requirements of clarity and precision,** not whether more suitable language or modes of expression are available. The claims merely need to define the patentable subject matter with a reasonable degree of particularity and distinctness. MPEP §2173.05(e) states that if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. As long as proper boundaries of the claim are defined, then the claim should be considered to be definite.

Accordingly, referring to the language in claims 36, 52 and 61, **these claims are not rendered indefinite by the use of the phrase “adapted to”.** Claim 36, for example, is directed to a search system which comprises a database, wherein the database is not any database, but instead is one which is adapted to store certain types of information. As such, the phrase

“adapted to” further defines the database and does not merely render the claim indefinite. Similar arguments can be made with regard to independent claims 52 and 61. Applicants note that each of these claims was present in the first Office Action issued by the Examiner, wherein no rejection under 35 U.S.C. §112, second paragraph, was given, and wherein the Examiner obviously understood the claims in some fashion as a prior art rejection was made (noting that the prior art rejection was, however, improper and subsequently withdrawn for the reasons indicated in the Amendment of December 23, 2003). Accordingly, withdrawal of the Examiner’s rejection is respectfully requested.

Prior Art Rejections

The Examiner has rejected claims 1-6, 12, 13, 17, 20-25, 33, 35-38, 40, 41, 44-46, 48, 49, 52-54, 56-57, 60-67, 69-76, and 79-137 under 35 U.S.C. §102(e) as being anticipated by Sherwin et al. This rejection is respectfully traversed.

Different 102(e) Dates for Different Portions of Sherwin Publication Number U.S.

2002/0052784

Initially, Applicants note that the Sherwin Publication Number U.S. 2002/0052784 published on May 2, 2002, was filed on July 27, 2001, **after the filing date of the present application**, namely after August 29, 2000. A provisional application was filed on July 28, 2000. **However, the disclosures of Publication Number U.S. 2002/0052784 and the provisional application are not identical.** Thus, while portions of the Sherwin Publication Number U.S. 2002/0052784 are entitled to the filing date of the provisional application, **other portions are only entitled to the filing date of July 27, 2001**, and thus cannot be used as a

reference against the present application.

Applicants have reviewed the content of the Sherwin Publication Number U.S. 2002/0052784 and the provisional application, and have found several inconsistencies. First, the provisional application only includes four figures, and thus all aspects of Figure 5, including the description thereof in U.S. 2002/0052784, cannot be used in a rejection against the claims of the present application. The claims of U.S. 2002/0052784 are also not present in the provisional application. **Also, most of the Summary of the Invention section was also not included in the provisional application, namely, paragraphs [0008], [0009], and [0010].** Finally, in paragraph [0026] of U.S. 2002/0052784, the first sentence is not completely supported by the provisional application document. Namely, the first sentence of paragraph [0026] in the provisional application document reads “after logging in, the affinity group’s shopping site where web-page 300 is called up by the consumer 50 or it preferably maintains and/or administers the same on the affinity group’s behalf.” This sentence obviously does not make sense and was apparently corrected when filing the complete application which was published as U.S. 2002/0052784.

Improper Rejections based on incorrect 102(e) Date

Initially, Applicants note that the Examiner rejected claims 1, 52, 61, 71 and 94-97 based upon paragraph [0009] of Published Application U.S. 2002/0052784. **This is clearly an improper rejection and must be withdrawn, as this paragraph is not supported by the provisional application** and thus is only entitled to a filing date of July 27, 2001, after the August 29, 2000 filing date of the present application. **Accordingly, withdrawal of this portion of the rejection is respectfully requested.**

Similarly, all rejections made based upon claims depending from any of independent claims 1, 52, 61, 71 and 94 are also improper. **Thus, all prior art rejections made with regard to any claims dependent upon any of claims 1, 52, 61, 71 and 94 must also be withdrawn.**

With regard to independent claims 22 and 110, these claims have been rejected, at least in part, **on paragraph [0026]**, which includes a first sentence which is not completely supported by the provisional application document. Accordingly, reconsideration and withdrawal of this rejection is also respectfully requested.

With regard to independent claim 36, this claim is also rejected, at least in part, **on paragraph [0009]** of U.S. 2002/0052784, which is also not supported by the provisional application document. **Thus the rejection of claim 36 and all claims dependent thereon, must also be withdrawn.**

Finally, regarding the rejection of independent claim 45, this rejection is based, at least in part, **on paragraph [0026]**, which includes a first sentence which is not completely supported by the priority document. **Thus, reconsideration and withdrawal of this rejection is also respectfully requested.**

U.S. 2002/0052784

U.S. 2002/0052784 is directed to an affinity shopping portal. More importantly, the patent is directed to a type of **“click through” portal system** wherein a user **is encouraged to click through several screens**, such that a click-through fee is generated and then is distributed to a number of groups. Specifically, as indicated in the abstract, shopper 50 is received at a first website maintained on a communication network, and is forwarded to a second website maintained on the network, obtaining a generated click-through fee related thereto. A portion of

the obtained click-through fee is distributed to a particular affinity group and as such, the generated click-through fee is apportioned to a number of people. The network is thus a **closed network** wherein a **finite registration database** includes only contracted merchants and affinity groups.

More specifically **within this closed network**, contracting merchants 30 are registered with a coordinator 10 and have negotiated with a coordinator 10 or individual affinity groups 40 to have hyper-links to their online websites included in selected ones or in all the affinity group shopping sites or web pages 300 maintained and/or administered by the coordinator 10. In return, the contracting merchants 30 have agreed to pay click-through fees for directing consumers 50 to them. The click-through fees are optionally calculated as a flat fee for each referral, a flat fee for each referral which makes a purchase, a percentage of each referral's purchases, or an otherwise determined amount. Records regarding registered merchants 30 are preferably maintained in the coordinator's **finite registration** database 14. See paragraph [0029] of U.S. 2002/0052784.

The affinity groups 40 also register with the coordinator 10 and have negotiated with the coordinator 10 to have their online shopping sites or web pages maintained and/or administered by the coordinator 10. In return, the affinity groups **have agreed to share derived or generated click-through fees with the coordinator 10**. See paragraph [0030] of U.S. 2002/0052784. When a consumer 50 activates one of the hyperlinks on one of the affinity group's 40 shopping site or web page 300, they are directed to a corresponding merchant 30 where they may call up or are otherwise provided access to the merchant's shopping site or web page 400. Thereafter, in the usual manner, the consumer 50 is free to shop online from the merchant's shopping site or web page 400. See paragraph [0031] of U.S. 2002/0052784.

Finally, the coordinator 10 periodically **collects or otherwise receives payment for the click-through fees** from the contracting merchants 30 in accordance with the agreed-upon terms. The coordinator 10 preferably retains a percentage, flat fee or rate, or otherwise determined share of the click-through fees as payment to cover the overhead and service rendered by the coordinator 10. What remains of the click-through fees is distributed to the affinity groups 40 in accordance with terms agreed upon between the coordinator 10 and the affinity groups 40. See paragraphs [0032] and [0033] of U.S. 2002/0052784.

Distinctions over U.S. 2002/0052784

Accordingly, **the goal in U.S. 2002/0052784 is to generate click-through fees within a closed network and to encourage a user to shop in a manner which generates click-throughs and thus click-through fees.** This is clearly contrary to the present application as set forth in claim 1, for example, which is directed to a search method. **A search method allows a user to avoid required click-throughs.**

A click-through system described in Sherwin, by definition, results in the direction to a closed set of subscribing merchant websites through hyperlinks, which may or may not be responsive to a specific user's objective. To the contrary, a search system surveys and may result in a broad array of sources of the goods, services, or information specifically sought by a user.

Further, the particular search method as set forth in claim 4, for example, allows a user to be provided with a search arrangement which includes an expandable synergistic concentric circle arrangement. Contrary to any such search expansion, a user using the system of U.S. 2002/0052784 cannot expand any search, but instead is first limited to a number and type of

determined merchants (registered in a closed network) which are displayed on an affinity group's webpage, and then is further limited to the particular merchant selected upon making a selection. There is no expandable searching, contrary to that set forth in claim 4 of the present application.

In an expandable synergistic concentric circle arrangement, the user's search objectives may further be defined and redefined, on the fly for example, resulting in either an expansion or contraction based on the user's own choices, of the universe of websites the application method makes available. Sherwin offers no such arrangement and thus no user-objective-based universe of responsive websites for example; nor any type of sequential, user-refined search objectives; nor any type of user-transaction-determined sharing of benefit. Whereas the click through system described in Sherwin by definition shares a fee for user "eyes and ears" directed to a site or sites by the administrator, a search system need share nothing, until and unless, for example, a transaction between user and user-selected website operator is concluded.

The present application as claimed in claim 4 for example, embraces an expandable, synergistic, concentric circle arrangement. A user using the system of U.S. 2002/0052784 is limited to a fixed number of pre-determined merchants which are displayed on an affinity group's webpage, and is further limited to the particular merchant selected upon making a selection. Sherwin is thus, essentially, a one-way, dead-end street, leading past a limited number of merchant storefronts pre-determined by the administrator, who receives a fee from those merchants for giving the user a tour of a narrowly landlocked stripmall in which the user's objectives may or may not be met, in order to garner drive-thru fees.

To the contrary, the present application as claimed in claim 4 for example, is more analogous to a GPS driving system, wherein the user enters coordinates and tells it where to start and where to go. In such a system, unless the user/driver arrives at coordinates that suits the user

and chooses to initiate and conclude a transaction there, no compensation need be paid to anyone; and there need not be anything to share.

Referring back to claim 1 of the present application, the claim is again directed to a search method. Thus, it allows a user to search, for example, an open field of information in an open network and to find something quickly; contrary to the click-through system of U.S. 2002/0052784. The click-through system of U.S. 2002/0052784 is administrator determined, relies upon sequential selections within a closed network, and encourages a cumbersome “click-through” system which generates “click-through fees” to benefit the administrator and certain affinity groups.

Claim 1 provides an arrangement for searching for a provider **based upon a search request** input to the computer device, wherein a provider associated with a beneficiary group associated with the user can be searched for. No such search request is needed in U.S. 2002/0052784, as instead of inputting a search request (which could lead to a direct and prompt selection of a provider), the user must go through a series of clicks to select one of the limited number of providers listed on an affinity group webpage. **Thus, instead of a provider, associated with a beneficiary group associated with the user, being locatable via a search request**, a user of U.S. 2002/0052784 must click through several screens and select from listed and displayed providers. This closed network system of a fixed number of previously determined merchants of U.S. 2002/0052784 includes a finite registration database and thus fails to meet the limitations of claim 1. Accordingly, for at least these additional reasons, claim 1 of the present application is patentable over U.S. 2002/0052784.

With regard to various ones of dependent claims 3-10 and 14-16, for example, these claims reference **synergistic concentric circle arrangements and expansion** of synergistic

concentric circle arrangements in various ways. No such synergistic concentric circle arrangement or expandable synergistic concentric circle arrangement is taught or suggested by U.S. 2002/0052784.

A non-limiting exemplary embodiment of a use of expandable synergistic concentric circles is described utilizing figures 8A-9 of the present application. Such a synergistic concentric circle arrangement and an expansion of any synergistic concentric circles may include variable search techniques and varying an input search request, which is completely different from the click-through method and closed network system of U.S. 2002/0052784. For example, an input search request can include a beneficiary group (such as the Korean Methodist Church for example) that the user wants to associate with (or such a beneficiary group can be pre-designated), and can include a location and/or product, etc. If the user is not satisfied with the search results, for example, the user can expand any aspect of the search request such as the beneficiary group, for example, to include any type of Korean church as shown in Figure 8B. The user can optionally geographically expand parameters, and/or can expand the search to include additional beneficiary groups as shown in Figure 9, for example. In any event, the use of such a synergistic concentric circle arrangement and the use of search expansion, as is claimed in various ways throughout many of the dependent claims of the present application including but not limited to claims 3-10 and 14-18, is clearly different from and clearly contrary to the closed network click-through system of U.S. 2002/0052784.

Somewhat similar to claim 1, independent claim 22 is also directed to a search method, receives a search request, and includes searching for a provider based upon the received request. No such request is necessary in U.S. 2002/0052784, as an affinity shopping portal is displayed and a merchant is selected from an internet portal of a closed network of selectable merchants.

Further, as claimed in claim 23, no type of expandable arrangement is shown in U.S. 2002/0052784. U.S. 2002/0052784 includes a closed system of a finite number of registered merchants, as opposed to a range of choices available in a search request, wherein such a range is expandable.

Somewhat similar arguments apply with regard to independent claim 36, which includes a controller adapted to receive a search request; claim 45 which is directed to a computer search method and receives a search request; claim 52 which is directed to a search system including a controller adapted to provide an arrangement for searching for a provider based upon the search request; claim 61 directed to a system including a controller adapted to provide an arrangement ... based upon a request received from a computer device; claim 71 directed to a search method providing an arrangement ... based upon a search request; claim 94 directed to a method including providing an arrangement ... based upon a received request; and claim 110 directed to a method including receiving ... a request. No such requests are necessary in U.S. 2002/0052784, as the click-through portal provides a different type of click-encouraged shopping through a closed network of selected merchants.

Accordingly, withdrawal of the Examiner's rejections are respectfully requested.

Further Prior Art Rejections

The Examiner rejects further ones of the dependent claims of the present application under 35 U.S.C. §103 as being unpatentable over U.S. 2002/0052784 in view of Dunworth et al. This rejection is respectfully traversed.

No Motivation to Combine

Initially, Applicants respectfully submit that there is no motivation for one of ordinary skill in the art to combine the teachings of U.S. 2002/0052784 (Sherwin et al) with that of Dunworth et al. The Dunworth et al. patent is directed to a searching system which can search information, wherein some of the information can be based on geography. **Such an open system, which allows a user to search a large database, has nothing to do with a closed network click-through system,** wherein click-throughs are encouraged, such as that of U.S. 2002/0052784. There is no search request even necessary in U.S. 2002/0052784, let alone a search request which has anything to do with geography. Thus, even assuming arguendo that Dunworth did teach prior art expansion of information based on geography, as alleged by the Examiner, there is no teaching or suggestion in either reference of utilizing such a prioritized expansion of a search request in combination with a click-through system such as that of U.S. 2002/0052784. The two systems are completely distinct. Thus it would not have been obvious to one of ordinary skill in the art to combine their teachings.

Further, in order to establish a proper prima facie case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. The motivation, suggestion or teaching, may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases, the nature of the problem to be solved. See *In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999). There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from Applicants' invention itself. See *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992). See *Dembiczak* 50 USPQ 2d. 1617.

At best, the Examiner has merely issued broad conclusory statements, which are not evidence of motivation. The Examiner has not explained what in the teachings of Dunworth et al., and/or the teachings in US 2002/0052784, would provide one of ordinary skill in the art with any type of motivation to combine their teachings. The Examiner merely alleges, **in his own opinion,** that the references could be combined because "Dunworth's teaching would have allowed Sherwin's to allow the user the flexibility to organize the search information according to the user's desire in order to meet user search criteria (column 2, lines 54-58)." **However, there is no type of search necessary in US 2002/0052784 (Sherwin), as click-throughs do not involve searching, let alone expansive searching.** There is no organization of any type of search information even possible in US 2002/0052784, as the affinity group website is closed and fixed and is already determined such that a user can select one of a limited number of determined merchants from which to purchase. The user cannot expand this group.

Further, Applicants note that **the Examiner's opinion is not evidence,** and as such cannot be used as motivation, teaching or suggestion for one of ordinary skill in the art to combine the teachings of the prior art references. The Examiner must provide evidence as to why one of ordinary skill in the art would have been motivated to select and combine the reference teachings. Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not the proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

Somewhat similarly, the Examiner cannot rely on any type of design choice or personal knowledge as a reason for combining the teachings of the various references. This is again not the proper standard for obviousness. If the Examiner is relying on personal knowledge to

support a finding of what is known in the art, the Examiner **must provide** an Affidavit or Declaration setting forth specific factual statements and explanations to support the finding. See 37 CFR §1.104(d) and MPEP 2144.03(c). Accordingly, Applicants respectfully challenge the Examiner's alleged motivation and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained.

In addition, even assuming arguendo that the references could be combined, which Applicants do not admit, Dunworth et al. would still fail to make up for the previously mentioned deficiencies of US 2002/0052784 with regard to the corresponding independent claims. Thus, withdrawal of the rejection is respectfully requested.

CONCLUSION

Accordingly, in view of the above remarks, reconsideration and withdrawal of all outstanding rejections and allowance of each of claims 1-137 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

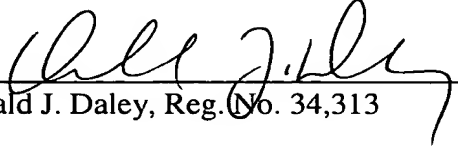
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any

additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By: _____


Donald J. Daley, Reg. No. 34,313

DJD/psy/bof

P.O. Box 8910
Reston, Virginia. 20195
(703) 668-8000

| | | | | | | |
|---|-----------------|---|-----------------|-------------------------------|--------------|--|
| Form PTO-1449 INFORMATION DISCLOSURE CITATION IN AN APPLICATION (Use several sheets if necessary) | | ATTY DOCKET NO. 35030-000101 | | APPLICATION NO. 09/650,046 | | |
| | | APPLICANT William T. Geddes Jr. et al. | | CONF. NO. Unknown | | |
| | | FILING DATE August 29, 2000 | | GROUP 2161 | | |
| U.S. PATENT DOCUMENTS | | | | | | |
| EXAMINER INITIAL | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB CLASS | FILING DATE IF APPROPRIATE |
| | | | | | | <div style="font-size: 2em; font-weight: bold;">RECEIVED</div> |
| | | | | | | JUL 16 2004 |
| | | | | | | Technology Center 2100 |
| | | | | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | |
| | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB CLASS | TRANSLATION YES NO |
| | | | | | | |
| | | | | | | |
| | | | | | | |
| | | | | | | |
| | | | | | | |
| OTHER DOCUMENTS (Include Name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.) date, page(s), volume-issue number(s), publisher, city and/or country where published. | | | | | | |
| | | "New Spin On Affiliate Retailing", Ted Kemp, <u>News & Analysis</u> , November, 2001. | | | | |
| | | "The Way To Save For College", <u>www.upromise.com</u> , November, 2001. | | | | |
| | | "The Sharper Image", <u>www.sharperimage.com</u> , November, 2001. | | | | |
| | | "The Sharper Image - Affiliate Program", <u>www.sharperimage.com</u> , November, 2001. | | | | |
| | | | | | | |
| | | | | | | |
| EXAMINER | | | DATE CONSIDERED | | | |
| EXAMINER: Initial if citation considered, whether or not citation is in conformance with M.P.E.P. 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | | | | | | |